REMARKS

The Office Action has been reviewed and carefully considered. Claims and have been

amended. Claims 1-18 and 44-68 are pending in the application.

In paragraph 2 on page 2 of the Office Action, corrected drawings were required.

Applicants have included replacement drawings attached hereto.

In paragraph 3 on page 2 of the Office Action, claims 13, 14 and 67 were rejected under

35 U.S.C. § 102(e) over Herriot (Patent No. 6,134,583).

On page 9 of the Office Action, claims 15-18 were rejected under 35 U.S.C. 103(a) as

being unpatentable over the combination of Herriot as applied to claim 13 above, and further in

view of Boland et al. U.S. Patent No. 6,209,062 (hereinafter Boland). According to the Office

Action, Herriot teaches all the limitations of claim 13 but it does not explicitly teach the method

of deleting previously captured objects to increase available capture storage area in the memory.

On page 11 of the Office Action, claim 68 is rejected under 35 U.S.C. 103(a) as being

unpatentable over the Herriot as applied to claim 67 above, and further in view of Boland et al.

U.S. Patent No. 6,209,062 (hereinafter Boland). According to the Office Action, Herriot teaches

all the limitations of claim 67 but it does not explicitly disclose a system that deletes previously

captured objects to increase available capture memory.

Applicants respectfully traverse the rejections, but in the interest of expediting

prosecution have amended the claims.

Herriot discloses a procedure for obtaining a copy of a data object. A client computer

provides a server a request for a data object. The request includes a location-independent

identifier associated with the desired data object. The server computer interrogates a cache to

determine whether a copy of the data object is cached. If the data object is cached, the server

computer obtains a copy of the cached data object from the cache. If the data object is not cached, the server computer performs a network call to obtain a new copy of the data object. A client computer traverses cache table to search for a matching OID value. When a match is found, the client computer then references the corresponding cache pointer column for that row, which points to a cache element within the cache. A client computer then copies the cache element from cache to its own memory.

However, Herriot does not suggest that copying the cache element to its own memory is the same as capturing the presentation object. Rather, capturing refers to specifically storing the object in persistent memory so that the object stays in the printer over power cycles. Moreover, Herriot fails to suggest downloading to a printer a presentation object identified in a print data stream. Rather, Herriot merely provides for the caching of objects and then copying the object to its memory, which may be volatile memory and therefore does not necessarily equate with "capturing."

Further, Herriot fails to suggest storing an object in memory of a printer if a globally-unique identifier has been assigned to the presentation object. Rather, Herriot discloses storing the object in memory of a client computer, whereas Applicant stores an object in persistent memory of a printer. Thus, Office Action fails to establish that Herriot teaches, discloses or suggests all of the elements of Applicant's application.

Boland fails to remedy the deficiencies of Herriot. Boland merely discloses a memory management system wherein pages in cache memory designated for recycling are maintained in the cache, while pages that are not are first replaced. According to Boland, pages in the cache that are likely to be accessed in the near future are those that are accessed by two or more different transactions during their normal residence in the cache. However, Boland, like Herriot,

fails to suggest downloading to a printer a presentation object identified in a print data stream, caching the presentation object in a cache of the printer when the presentation object is downloaded and capturing the presentation object in memory of the printer if a globally-unique identifier has been assigned to the presentation object.

Because the Office Action fails to establish that Herriot and Boland, alone or in combination, teaches, discloses or suggests all of the elements of the instant invention, Applicant requests that the rejections be withdrawn.

On 4 of the Office Action, claims 1-12 and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Herriot U.S. Patent No. 6,134,583 in view of Myers et al. U.S. Patent No. 6,134,583 (Hereinafter Myers).

On 8 of the Office Action, claims 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Herriot and Myers as applied to claim 44 above, and further in view of Boland et al. U.S. Patent No. 6,209,062 (hereinafter Boland). According to the Office Action, the combination of Herriot and Myers teaches all the limitations of claim 44 but it does not explicitly disclose a system that deletes previously captured objects in the printer capture storage and previously downloaded or active objects. However, according to the Office Action, Boland discloses a memory management system that deletes previously captured objects or previously saved objects using a time stamp and thus creating available memory for the new data to be stored.

Applicants' invention, as recited in claim 1, requires at least identifying an object in a print data stream for presentation by a printing system and generating at the printing system a globally-unique identifier for assignment to a received object. Herriot fails to suggest identifying

an object in a print data stream. Herriot also fails to suggest that a globally-unique identifier is generated at the printing system for assignment to the object. Claim 44 recites similar elements.

Meyers fails to remedy the deficiencies of Herriot. Meyers merely discloses a globally unique transaction identifier, which is an identifier for a transaction method tree instance. The identifier is produced by the root transaction method (or the transaction service supporting it), and is propagated down the transaction tree constructed by subsequent invocations. The identifier may be used to correlate all arcs and nodes involved in a distributed, (possibly nested) set of transaction method instances. However, Meyers does not suggest identifying an object in a print data stream or generating at the printing system a globally-unique identifier for assignment to the object.

Boland fails to remedy the deficiencies of Herriot and Meyers. Boland merely discloses a memory management system wherein pages in cache memory designated for recycling are maintained in the cache, while pages that are not are first replaced. According to Boland, pages in the cache that are likely to be accessed in the near future are those that are accessed by two or more different transactions during their normal residence in the cache. However, Boland, like Herriot and Meyers, fails to suggest identifying an object in a print data stream or generating at the printing system a globally-unique identifier for assignment to the object.

Thus, Office Action fails to establish that Herriot, Meyers, and Boland, alone or in combination, teach, disclose or suggest all of the elements of Applicants' application.

Dependent claims 2-12 are also patentable over the references because they incorporate all of the limitations of the corresponding independent claims. Further, dependent claims 2-12 recite additional novel elements and limitations. Applicants reserve the right to argue

independently the patentability of these additional novel aspects. Therefore, Applicants respectfully submit that dependent claims 2-12 are patentable over the cited references.

Because the Office Action fails to establish that Herriot, Meyers, and Boland, alone or in combination, teaches, discloses or suggests all of the elements of the instant invention, Applicant requests that the Section 103 rejection be withdrawn.

In addition, Applicants respectfully submit that there is no motivation to combine the references to arrive at the claimed invention. To establish a *prima facie* case for rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art and evidence of motivation to combine prior art teachings must be presented. *See,* MPEP §§ 2143.03 and 2143.01 respectively. In this instance, as described below, neither of the requirements is present and a *prima facie* rejection fails under 35 U.S.C. § 103(a), and thus Applicants respectfully traverse the rejection.

The only support in the Office Action for the motivation to combine the references is the assertion that Herriot and Meyers both relate to accessing presentation objects identified by a globally unique identifier and to provide enable user to print downloaded globally unique presentation objects it would be obvious to combine the downloading OID objects of Herriot with the printing presentation objects of Myers. However, the Office Action does not cite to anything in Herriot or Meyers suggesting that downloading OID objects for printing the objects would be advantageous, or that even such a combination is desirable. Absent any support, the Office Action merely expresses the conclusory opinion that the references are combinable. Therefore, the burden of establishing evidence of motivation to combine prior art teachings has not been met.

On page 12 of the Office Action, claims 50-66 are rejected under 35 U.S.C. 103(a) as

being unpatentable over LeClair et al. U.S. Patent No. 6,636,891 (hereinafter LeClair) in view of Herriot. According to the Office Action, LeClair discloses a system for processing referenced object, comprising a print server for searching for an object referenced by selected indicia in a data stream, the selected indicia being a name and an object locator and a control unit for capturing the object. Additionally, according to the Office Action, LeClair discloses the secure communication link between the server and the client. Further, according to the Office Action, it is also inherent that the object is referenced a certain name since the object is retrieved to the server upon receiving the HTTP GET object request. Nevertheless, according to the Office Action, LeClair does not discloses expressly that the object is referenced by a globally-unique identifier wherein the control unit determines if the object is to be captured based upon whether the selected indicia includes a globally-unique identifier. Nevertheless, according to the Office Action, Herriot discloses a server for searching for an object referenced by a selected indicia in a data stream, the selected indicia being a name, a globally-unique identifier or a globally-unique identifier and an object locator wherein the system determines if the object is to be captured based upon whether the selected indicia include a globally-unique identifier

Applicants respectfully traverse the rejection, but in the interest of expediting prosecution have amended the claims.

Applicants invention as recited in claim 50 requires at least a print server for searching for a presentation object referenced by a selected indicia in a print data stream, the selected indicia being a name, a globally-unique identifier or a globally-unique identifier and an object locator and a control unit for capturing the presentation object in persistent memory, wherein the control unit determines if the presentation object is to be captured based upon whether the selected indicia includes a globally-unique identifier.

In contrast, LeClair merely describes a print server that receives print requests providing a network storage location of data. The print server queues such requests until the printer is ready. The print server then retrieves the data from the network storage location when the printer can execute the request. The print request includes an object locator indicating the network storage location for the data. However, LeClair at least does not suggest that the server controller determines whether a presentation object is to be captured based upon whether selected indicia in the request includes a globally-unique identifier.

Herriot fails to remedy the deficiencies of LeClair. Herriot merely suggests that a request for an object include a globally-unique identifier. Herriot does not suggest that the server controller determine whether a presentation object is to be captured based upon whether selected indicia in the request include a globally-unique identifier.

In addition, Applicants respectfully submit that there is no motivation to combine the references to arrive at the claimed invention. To establish a *prima facie* case for rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art and evidence of motivation to combine prior art teachings must be presented. *See,* MPEP §§ 2143.03 and 2143.01 respectively. In this instance, as described below, neither of the requirements is present and a *prima facie* rejection fails under 35 U.S.C. § 103(a), and thus Applicants respectfully traverse the rejection.
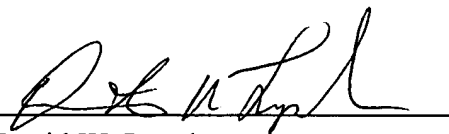
A Section 103(a) rejection can only be established by combining cited references to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See,* MPEP § 2143.01. The Office Action merely alleges that the motivation to combine the cited references to produce the claimed invention is

because both inventions disclose a secure communication link between the client and the server and it would be desirable to print globally unique identified objects using the print server of LeClair. However, the Office Action fails to establish where the references suggest why it is desirable that globally unique identified objects be printed in the first place. Further, the Office Action fails to establish any suggestion for combining the references to arrive at the claimed invention. Still further, the Office Action fails to establish that the references provide a suggestions for combining LeClair and Herriot to provide a server controller that determines whether a presentation object is to be captured based upon whether a selected indicia in the request includes a globally-unique identifier. Absent any support, the Office Action expresses the conclusory opinion that the references are combinable.

On the basis of the above amendments and remarks, it is respectfully submitted that the claims are in immediate condition for allowance. Accordingly, reconsideration of this application and its allowance are requested.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Attorney for Applicants, David W. Lynch, at 651-686-6633 Ext. 116.

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